



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,161	12/08/2003	Marco Serra	MDE-002C1	2317
42532	7590	02/11/2008		
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110			EXAMINER	
			VO, HAI	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			02/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,161

Applicant(s)

SERRA ET AL.

Examiner

Hai Vo

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58, 63, 65-75 and 78-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58, 63, 65-75, and 78-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1794

1. All of the art rejections have been withdrawn in view of the present amendment.

None of the prior art teaches or suggests the gel particles comprising reversible hydrophilic and hydrophobic constituents. However, upon further consideration, new grounds of rejections are made in view of Yeo (US 5,509,913), Inagaki et al (US 6,562,754), Mori et al (US 5,164,057) and JP 06-233809.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 58, 63, 65, 67-72, 75, and 78-84 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yeo (US 5,509,913). Yeo discloses a flushable article comprising a backsheet, an absorbent

core and a body side liner which contains a thermoreversible flushable polymer (example 17). The body side liner is in direct contact with the skin of the wearer of the article. The flushable polymer includes poly(n-isopropyl acrylamide) (PNiAm) which has reversible hydrophilic and hydrophobic constituents (column 10, lines 5-10). The flushable polymer comprises N-t-butylacrylamide, acrylic acid (column 10, lines 5-7, column 9, lines 30-35). The flushable article contains 20% by weight of the gel (example 3). The flushable article is a flushable foam. Yeo does not specifically disclose the flow control function of the thermoreversible flushable polymer. However, it appears that Yeo uses the same gel particles as Applicants, therefore it is not seen that the flow control function could not have been present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Further, it has been held that a recitation with respect to the manner in which a claimed material is intended to be employed does not differentiate the claimed material from a prior art flushable article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Accordingly, Yeo anticipates or strongly suggests the claimed subject matter.

5. Claims 58, 63, 67, 68, 70-72, 75, 78, 82 and 83 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inagaki et al (US 6,562,754). Note that an object is an intended use limitation; therefore any limitations associated with the object are not required by the claim. Inagaki discloses an apparatus comprising an absorbing core fixed to the surface of

the tube and heat transfer fins as shown in figure 3c. The absorbing core comprises a three dimensional network structure of an inorganic material and an organic material dispersed in the structure (column 3, lines 60-65). The organic material includes PNiAm which has reversible hydrophilic and hydrophobic constituents (column 6, lines 20-30, column 12, lines 55-60). The absorbent desorbs water when heated and absorbs water when chilled. Inagaki does not specifically disclose the flow control function of the thermoreversible polymer. However, it appears that Inagaki uses the same gel particles as Applicants, therefore it is not seen that the flow control function could not have been present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Further, it has been held that a recitation with respect to the manner in which a claimed material is intended to be employed does not differentiate the claimed material from a prior art absorbent core satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Accordingly, Inagaki anticipates or strongly suggests the claimed subject matter.

6. Claims 58, 63, 67, 68-72, 75, and 78-83 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori et al (US 5,164,057). Note that an object is an intended use limitation and anything associated with the object is not required by the claim. Mori discloses an electrophoretic matrix for separation of proteins comprising a supporting porous membrane and a layer of a temperature sensitive polymer grafted on the supporting

material (column 6, lines 10-25). The temperature sensitive polymer includes polyacrylic acid, PNiAm which have reversible hydrophilic and hydrophobic constituents (column 4, lines 45-65, column 5, lines 1-30). The PNiAm constitutes about 5 wt% (example 1). The protein is coated on the surface of the porous membrane (column 7, lines 20-25). Mori does not specifically disclose the flow control function of the thermoreversible polymer. However, it appears that Mori uses the same gel particles as Applicants, therefore it is not seen that the flow control function could not have been present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Further, it has been held that a recitation with respect to the manner in which a claimed material is intended to be employed does not differentiate the claimed material from a prior art electrophoretic matrix satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Accordingly, Mori anticipates or strongly suggests the claimed subject matter.

7. Claims 58, 63, 66-72, 75, and 78-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (US 5,571,080) in view of JP 06-233809. Jensen discloses a surgical dressing comprising a fibrous substrate, a fluid impervious backing wherein the backing is made from neoprene rubber (claim 8). Jensen does not teach a fibrous substrate containing a hydrocolloid material that swells and become a gel when hydrated. The surgical dressing includes 8-65 wt% hydrocolloid (column 4, lines 50-55). Jensen does not teach the hydrocolloid material comprising

reversible hydrophobic and hydrophilic constituents. JP'809, however, teaches a wound dressing comprising a substrate comprising a temperature sensitive polymer such as PNiAm, polyacrylic acid to provide wound dressing with good absorbing characteristics and easy removal from the wound surface. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the temperature sensitive polymer for the hydrocolloid material motivated by the desire to provide wound dressing with good absorbing characteristics and easy removal from the wound surface. Jensen as modified by JP'809 does not specifically disclose the flow control function of the temperature sensitive polymer. However, it appears that Jensen/JP'809 uses the same gel particles as Applicants, therefore it is not seen that the flow control function could not have been present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

8. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (US 5,571,080) in view of JP 06-233809 as applied to claim 58 above, further in view of EP 0 301 753. Jensen does not specifically disclose a wound dressing comprising a foam substrate as a wound contacting material. EP'753, however, teaches a wound dressing comprising a backing, and an open cell foam matrix containing hydrogel particles in an amount from 20 to 40% by weight (abstract, column 5, lines 40-45, figures 3 and 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the foam material for the

fibrous substrate because the foam material and fibrous material have been shown in the art to be recognized equivalent wound contacting materials for surgical dressings.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax

Art Unit: 1794

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV

/Hai Vo/
Hai Vo
Primary Examiner, Art Unit 1794